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Paper No. 7

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OFFICE OF PETITIONS

In re Application of: :
Rafie, et al.   :
Application No. 09/764,202   :   ON PETITION
Filed: 17 January, 2001   :
Attorney Docket No. 10506/3   :

This is in response to the petition under 37 C.F.R. §1.47(b)[1] filed herein on 23 July, 2001, and treated as a petition under 37 C.F.R. §1.47(a).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)" and <u>may</u> include an oath or declaration executed by the inventor.

<u>Failure to respond will result in abandonment of the application.</u>

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[1] The regulations at 37 C.F.R. 1.47 provide:
§ 1.47 Filing when an inventor refuses to sign or cannot be reached.
 (a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.
 (b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.
 (c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).
[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

BACKGROUND

The record indicates that:

- this application was filed on 17 January, 2001, without an oath or declaration;

- a Notice to File Missing Parts of Nonprovisional Application was mailed on 27 April, 2001, requiring an executed oath or declaration, and the surcharge set forth in 37 C.F.R. §1.16(e);

- a declaration executed by Inventors Rafie, Hwang, and Lu, the required surcharge, and a petition with attachments were filed on 23 July, 2001.

ANALYSIS

Petitioner has failed to:

- provide the last known address for Tushar Shah;

- establish that the inventor has been presented with the full application and has refused to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events with support of the registered practitioner prosecuting this matter) or cannot be reached.

A copy of the application papers must be sent to the last known address of the non-signing inventor with a request that he/she sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone, continue to fail, then applicant will have established that the inventor cannot be reached. Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address.

The statement of fact of Richard Silverstein states that correspondence was forwarded to Mr. Shah's current place of employment and to Mr. Shah's attorney, and that he received signed acknowledgments of receipt of the correspondence. However, the statement does not specify what documents

were included in the correspondence. Further, delivery of the correspondence to an employer and attorney does not establish that the correspondence was sent or given to the non-signing inventor.

The summary of the meeting between Josef Berger and Andrew Fine on 14 May, 2001, given by Mr. Silverstein in his statement, is insufficient to establish that the non-signing inventor orally refused to sign the declaration, because there is no evidence on the record that Mr. Berger, Mr. Fine, or Mr. Silverstein have first-hand knowledge of the refusal of Mr. Shah to sign the declaration.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
                  Box DAC
                  Washington, D.C. 20231

By FAX: (703) 308-6916
                  Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
                  2201 South Clark Place
                  Arlington, VA   22202

Telephone inquiries concerning this matter may be directed to Kathy Matecki at (703) 305-1645.

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  for Patent Examination Policy